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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,804	12/22/2000	Jennifer L. Hillman	PF-0576-1 DIV	5165

7590

02/13/2002

INCYTE GENOMICS, INC.
PATENT DEPARTMENT
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EXAMINER

HUTSON, RICHARD G

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 02/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,804

Applicant(s)

HILLMAN ET AL.

Examiner

Richard G Hutson

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants preliminary amendment canceling claims 21-34, Paper No. 3, 12/22/2000, is acknowledged. Claims 1-20 are present for examination.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2, 13 and 14, drawn to an isolated extracellular adhesive protein (EXADH), classified in class 530, subclass 350.
- II. Claims 3-6, 8 and 9, drawn to an isolated polynucleotide which encodes an extracellular adhesive protein, a host cell comprising said polynucleotide and a method of expressing said polynucleotide, classified in class 435, subclass 69.1.
- III. Claims 7 and 20, drawn to an antibody against an extracellular adhesive protein, classified in class 530, subclass 387.9.
- IV. Claim 10-12, drawn to a method of detecting a target polynucleotide encoding an extracellular adhesive protein, classified in class 435, subclass 6.
- V. Claims 15 and 16, drawn to a method for screening a compound for effectiveness as an agonist/antagonist of an extracellular adhesive protein, classified in class 436, subclass 86.
- VI. Claim 17, drawn to a method for screening a compound for effectiveness in altering expression of a target polynucleotide encoding an extracellular adhesive protein, classified in class 435, subclass 6.

- VII. Claim 18, drawn to a method of assessing toxicity of a test compound, classified in class 435, subclass 6.
- VIII. Claim 19, drawn to a diagnostic test for a condition or disease associated with the expression of EXADH, classified in class 435, subclass 7.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the extracellular adhesive protein of Group I, the polynucleotide encoding an extracellular adhesive protein of Group II and antibody against the extracellular adhesive protein of Group III each comprise a chemically unrelated structure capable of separate manufacture, use and effect. The polypeptide of Group I and the antibody of Group III are each comprised of different amino acid sequences and the polynucleotide of Group II is made up of a nucleic acid sequence. The DNA has other utility besides encoding protein such as a hybridization probe, and the proteins can be made synthetically. Additionally, the protein can be used to perform specific biological function(s) which are independent of the function(s) of the DNA molecule. The protein has other utility such as for the identification method of Groups III.

Inventions II and IV, VI or VII are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1)

the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polynucleotide of group II can be used to synthesize the protein of group I.

The polypeptide of Group I and the antibody of Group III are unrelated to the methods of Groups IV, VI or VII as they are neither used nor made by the methods of Groups IV, VI or VII.

Inventions I and V are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polypeptide of Group I can be used in a materially different process such as synthesize antibodies.

The polynucleotide of Group II and the antibody of Group III are unrelated to the method of Group V as they are neither used nor made by the method of Group V.

Inventions III and VIII are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the antibody of

group III can be used in a materially different process such as a method of purification of the polypeptide of Group I.

The polypeptide of Group I and the polynucleotide of Group II are unrelated to the method of Group VIII as they are neither used nor made by the method of Group VIII.

The methods of Groups IV-VIII are independent as they comprise different steps, utilize different products and produce different results.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the literature and sequence searches required for each of the Groups are not required for another of the Groups, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G Hutson whose telephone number is (703) 308-0066. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (703) 308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read "Richard Hutson", with a horizontal line extending to the right.

Richard Hutson, Ph.D.
Patent Examiner
Art Unit 1652
February 9, 2002